

### **REMARKS**

Claims 1, 14, 20 and 25-126 are pending upon entry of the amendments above. Claims 2 to 13, 15 to 19 and 21-24 have been cancelled without prejudice or disclaimer and Applicants reserve the right to pursue the subject matter of these claims in related applications.

Claims 25-126 have been added to expand the embodiments of the provisionally elected group (see below). New claims 25-126 are completely supported by the specification as originally filed. Specifically, support for the newly filed independent claims 25, 50, 73, 98 and 121, as well as dependent claims 26-32, 51-57, 74-80 and 99-105, can be found in the application as originally filed, for example, at page 3, lines 29-32; at page 7, lines 23-33; at page 10, line 15 through page 11, line 36; at page 57, line 22 through page 66, line 28; and at page 79, line 1 through page 83, line 37. Furthermore, support for newly added dependent claims 33, 58, 81 and 106 may be found, for example, at page 41, lines 24-32; support for newly added dependent claims 34-36, 59, 60, 82-84, 107, 108, and 122-124 may be found, for example, at page 79, lines 1-34; support for newly added dependent claims 37-39, 61-63, 85-87 and 109-111 may be found, for example, at page 95, line 19 through page 96, line 2; support for newly added dependent claims 40, 43, 64, 67, 88, 91, 112 and 115 may be found, for example, at page 96, line 3 through page 97, line 2; support for newly added dependent claims 41, 65, 89 and 113 may be found, for example, at page 81, lines 6-19; support for newly added dependent claims 42, 66, 90 and 114 may be found, for example, at page 93, line 29 through page 94, line 7; support for newly added dependent claims 44, 45, 68, 69, 92, 93, 116, 117, 125 and 126 may be found, for example, at page 98, line 33 through page 99, line 24; support for newly added dependent claims 46, 70, 94 and 118 may be found, for example, at page 89, line 29 through page 90, line 25; support for newly added dependent claims 47, 71, 95 and 119

may be found, for example, at page 83, lines 3-13; and support for newly added dependent claims 48, 49, 72, 96, 97 and 120 may be found, for example, at page 110 lines 20-31.

Accordingly, no new matter has been introduced.

### **Restriction Requirement**

The Examiner has required an election under 35 U.S.C. § 121 of one of the following groups:

- I. Claims 1-13, 15-19 and 23, in so far as they are drawn to polynucleotides of TR9, vectors, host cells and a method for producing a polypeptide recombinantly, classified in class 536, subclass 23.5, class 435, subclasses 320.1, 252.3 and 69.1, for example.
- II. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO:6, classified in class 536, subclass 23.5.
- III. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO:7, classified in class 536, subclass 23.5.
- IV. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO:8, classified in class 536, subclass 23.5.
- V. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO:9, classified in class 536, subclass 23.5.
- VI. Claim 14, in so far as it is drawn to polynucleotide of SEQ ID NO:10, classified in class 536, subclass 23.5.
- VII. Claims 20, 21 and 24, drawn to TR9 polypeptides, classified in class 530, subclass 350.
- VIII. Claim 22, drawn to antibodies to TR9, classified in class 530, subclass 388.22, for example.

See, Paper No. 6, page 2. The Examiner contends that the inventions are distinct, each from the other.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of group VIII as represented by originally filed claim 22, and drawn to antibodies to TR9, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Additionally, should the present restriction requirement be made final, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants point out that claims 2 to 13, 15 to 19, and 21 to 24 have been canceled and that new claims 25 to 126 are directed to subject matter falling within the ambit of group VIII as cast by the Examiner.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement.

As a threshold matter, Applicants point out that M.P.E.P. § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a “serious burden.” See M.P.E.P. § 803.

In the present situation, no such showing has been made. Although the Examiner has argued that groups I through VIII are distinct, Applicants nonetheless submit that a search of the claims of group I would also provide useful information for the claims of groups II through VIII, while a search of the claims of group VII would also provide useful information for the claims of groups I through VI and VIII. For example, in many if not most publications disclosing a polynucleotide, the authors also routinely include polypeptides encoded thereby as well as antibodies that bind such polypeptides. Since the searches for polynucleotides, polypeptides and antibodies commonly overlap, the search

and examination of a polynucleotide and the corresponding polypeptides as well as antibodies it binds, would not entail a serious burden.

Applicants also respectfully point out that the Examiner has classified groups I through VI in the same class and subclass (class 536, subclass 23.5), so that contrary to the Examiner's assertion, they have not "acquired a separate status in the art because of their different classification," and would not present a serious burden to search and examine together. *See* Paper 6, page 4.

Accordingly, in view of M.P.E.P. § 803, the claims of all groups I-VIII should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that the instant claims be examined in one application.

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application.

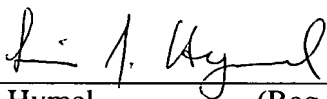
**Conclusion**

In view of the foregoing remarks, Applicants believe that this application is now in condition for substantive examination. The Examiner is invited to call the undersigned at the phone number provided below if any further action by applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Enclosures  
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